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No. 95-26

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND ALTHON ENTERPRISES, INC.,
Respondents.

On Writ Of Certiorari To The United States Court of Appeals for the Federal Circuit

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BRIEF OF AMICUS CURIAE THE ASSOCIATION OF TRIAL LAWYERS OF AMERICA IN SUPPORT OF THE PETITIONERS

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IDENTITY AND INTEREST OF *AMICUS CURIAE*

The Association of Trial Lawyers of America ["ATLA"] is a national organization of American trial lawyers dedicated to the preservation of the adversary system, to trial by jury, to advancement of the science of jurisprudence and to promotion of the administration of justice for the public good.

ATLA has no interest in any of the parties or in which side ultimately wins this lawsuit on the merits. Rather, its

interest is in the important issue that this case raises, concerning the reclassification of patent claim interpretation from a question of fact to a question of law, thus impacting the existing Constitutional right to trial by jury.

Letters of consent from the parties to the filing of this brief have been filed with the Court.

SUMMARY OF THE ARGUMENT

Unless the Federal Circuit's split decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed Cir. 1995) (*en banc*) is reversed, the ramifications upon patent litigation will be detrimental to the fundamental rights protected by the Seventh Amendment of the United States Constitution and will signify an abrupt departure from federal precedent.

First, the Federal Circuit, in its majority opinion, completely ignores historical precedent and the foundation laid by this Court, with its unique decision that disputed patent claim interpretation will no longer be a question of fact for the jury, as it has been for hundreds of years, and instead, will now fall within the realm of the court as a question of law.

Second, the decision below is in direct conflict with this Court's interpretations of the Federal Rules of Evidence in determining which issues must be decided by the court and which issues must be decided by the trier of fact.

Third, it is an attempt by the Federal Circuit to trump the fundamental guarantees under the Seventh Amendment by taking away decisions that have always been squarely placed in the hands of a jury.

Considering the severity of the Federal Circuit's decision upon all patent infringement litigation cases, and its potential

for erosion of the Constitutional right to trial by jury in other fields of civil law, this Court must review the Court of Appeals' decision with the utmost scrutiny. This decision is an absolute *departure* from the basic principles of what issues are factual and, consequently, what is within the realm of the trier of fact.

The underlying premise of the Federal Circuit's holding is that issues involving specialized areas of the law, such as patent law, which generally require the assistance of expert testimony, are too complicated for handling by juries, and instead should only be decided by judges. Such a premise signifies the destruction of a fundamental right guaranteed by the United States Constitution and the foundation of American jurisprudence since its inception --- the Constitutional right to trial by jury.

ARGUMENT

I. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO MANIPULATE PRECEDENT BY RECLASSIFYING DISPUTED PATENT CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT

The ultimate issue in patent infringement cases is determining whether or not infringement has taken place. The first step in determining infringement is to construe the "claims" in the patent. *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985). Within patent law, a "claim" serves as the framework for the patented item:

> The claims of the patent provide the concise formal definition of the invention. They are the numbered paragraphs which "particularly [point] out and distinctly [claim] the subject

> matter which the applicant regards as his invention." 35 U.S.C. § 112. It is to these wordings that one must look to determine whether there has been infringement.

Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1258 (Fed. Cir. 1989); *Autogiro Co. of America v. United States*, 384 F.2d 391, 395-96 (1967). Next, the properly construed claims are compared to the alleged infringing device. *Loctite*, 781 F.2d at 866. The purpose of claim construction is to determine how other persons who are skilled in the art would construe the terms in the claims. *Id.*

Prior to *Markman*, claim interpretation was separated into two possible alternatives. *See Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986); *cf., Markman v. Westview Instruments, Inc.*, 52 F.3d at 977. One: In situations in which the terms in the claims and the underlying *facts were not in dispute*, the issue of claim interpretation has always been treated as a *question of law*. *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989). Two: If the terms and *facts were in dispute*, the issue of claim interpretation has always been held as a *question of fact*. A significant majority of appellate cases reflect the developed line of precedent establishing patent claim construction as an issue of fact when conflicting evidence is presented by the parties.[1]

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[1] *See e.g., Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Snellman v. Ricoh Co.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 613 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

A. The Jurisprudential Foundation Of Disputed Claim Interpretation Being A Question Of Fact, Rather Than A Question of Law, Has Its Genesis In The Precedent Of This Court

Precedent established by this Court and relied upon in *Markman*, is the correct starting point for claim interpretation; however, the majority's reliance is based upon a misinterpretation of that established law. *See Markman*, 52 F.3d at 994.

In *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1853), a decision allegedly relied upon by the majority in *Markman*, this Court refused to take disputed factual issues away from the jury. This Court specifically held that it was the jury's role to determine what the patent claims covered, in light of the conflicting evidence, as part of the overall analysis of whether infringement had occurred. *Id.* at 225-26. This Court further construed and classified this determination as a matter of fact for the jury to decide. *Id.*

In *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870), the issue presented was the identity of the invention, and this Court again reiterated that the meaning of disputed terms of art is "a question of fact for the jury." *Id.* at 814. In a bewildering reversal of interpretations, the Court of Appeals majority in *Markman* relies upon *Bischoff* as alleged support for taking factual determinations away from the jury. *Markman*, 52 F.3d at 977.

This utilization of *Bischoff* is even more surprising in that this Court's holding in *Bischoff* was extremely clear and totally to the contrary of *Markman*. This Court held that even in situations in which the facts are so clear that there is no need for an expert to explain the terms of art, the question itself, in determining the meaning of the terms of art, remains one of fact for the jury. *Bischoff*, 76 U.S. at 814. This Court specifically held that a party does not have a right to demand from the court that these issues be decided as a matter of law. *Id.*

This Court again considered this issue of disputed terms of art in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872), holding that evidence of a prior patent and expert testimony concerning that issue were improperly withheld from a jury when the trial court was presented with a mixed question of law and fact.

The issues surrounding mixed questions of law and fact are extremely relevant to the matter at bar. In *Tucker*, the Court recognized that even in situations where the disputed factual question is minor in comparison to the legal issue, the essential nature of the trial mandates that the case be given to the jury. *Id.* at 455. Accordingly, even if *undisputed* claim interpretation is a matter of law, when the evidence presented by the parties is in conflict, claim interpretation is a question of fact. According to *Tucker*, in situations that involve hybrid scenarios concerning issues of fact and of law, the questions must be submitted to the jury. *Id.*

In a final attempt by the Federal Circuit to gain some semblance of support, the majority cites a string of other Supreme Court cases. *Markman*, 52 F.3d at 977-78. However, as with those cases noted above, these cases provide only facial support and offer no substantive basis for this radical departure from precedent. *See Hogg v. Emerson*,

47 U.S. (6 How.) 437 (1848); *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180 (1805); *Loom Co. v. Higgins*, 105 U.S. 580 (1881); *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942). Some of these cases say absolutely nothing about removing disputed factual questions from the jury, while other cases were decided under bills in equity.

The bottom line is that none of this Court's prior decisions cited by the majority in *Markman* offer any support for the proposition that claim interpretation is a question of law for the court when disputed evidence is provided by the litigants.

B. The Federal Circuit Blatantly Ignores That The Majority Of Court Decisions Considering The Issue Of Disputed Claim Interpretation, Including Its Own Precedent, Have Found The Issue To Be A Question Of Fact.

By using the groundwork laid by this Court as precedent, the majority of the decisions by lower courts that have contemplated this issue have found disputed patent claim interpretation to be a question of fact for the jury. *See e.g., Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Snellman v. Ricoh Co.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987); *Tandom Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017 (Fed. Cir. 1987); *Vieau v. Japax, Inc.*, 823 F.2d 1510 (Fed. Cir. 1987); *Data Line Corp. v. Micro Technologies, Inc.*, 813 F.2d 1196 (Fed.

Cir. 1987); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 613 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984). This established precedent is either completely ignored or inappropriately criticized in *Markman*. A review of these cases demonstrates the severe and drastic shift of the Federal Circuit in *Markman* away from any reputable, established case law on point.

The first case to directly address the issue at bar is *McGill, Inc. v. John Zink Co.*, 736 F.2d 666 (Fed. Cir. 1984). The parties had presented conflicting evidence regarding the meaning of terms in the claims contained in the patent specification. *Id.* at 668-69. The Court of Appeals recognized that, when disputed extrinsic evidence is used to explain the meaning of a term of art in the claims, the construction of the claims could be left to the jury as the finders of fact. *Id.* at 672. The court further determined that the jury could *not* be instructed as to the meaning of the disputed term of art from the court as a matter of law. *Id.*

The Federal Circuit further strengthened its position that disputed claim interpretation is a question of fact in *Palumbo v. Don-Joy Co.*, 762 F.2d 969 (Fed. Cir. 1985). The trial court had granted a summary judgment motion in favor of the defendant on the grounds that, after the court interpreted the terms in the disputed claims, there was no genuine issue of fact. *Id.* at 971-72. The Federal Circuit reversed, noting:

> If the language of a claim is not disputed, then the scope of the claim may be construed as a matter of law. [Citation] But when the meaning of a term in a claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction.

Id. at 974.

In *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986), the issue before the trial court also concerned the interpretation of the disputed terms, "electrode," "electrode body," and "disposed in said body," in the patent claims. The Federal Circuit recognized that the meaning of the terms were disputed by the parties, recognized the conflicting evidence surrounding the meaning of the terms, and held that the matter required a trial by jury because it raised a genuine issue of fact. *Id.* at 657.

The Federal Circuit again found disputed claim interpretation to be a question of fact in *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed. Cir. 1987). In that case, the dispositive issue was the interpretation of the term, "bottomless trench," used in a patent claim. *Id.* at 388-89. The Federal Circuit affirmed the decision of the trial court, finding that disputed meaning of terms within patent claims are questions to be decided by the trier of fact -- which in the situation of a preliminary injunction was the trial court. *Id.* at 389.

In *Tillotson, Ltd. v. Walbro Corp*, 831 F.2d 1033 (Fed. Cir. 1987), the Federal Circuit held that when a claim is in dispute, and it is necessary to look to extrinsic evidence presented by the parties, the underlying interpretation is a question of fact creating a sufficient dispute that must survive a summary judgment motion. *Id.* at 1037.

In *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546 Fed. Cir. 1991), the Federal Circuit again reached the same conclusion that claim interpretation, when the meaning of a term in a patent is subject to varying interpretations or ambiguity, can be a question of fact to be decided by the jury. *Id.* at 1549-50.

As these and the many other cases that have followed this line of reasoning show, prior to the decision below in *Markman*, lower courts including the Federal Circuit developed a well-established and understood principle of patent law: When the meaning of terms in patent claims is disputed and conflicting extrinsic evidence is presented by the parties, claim interpretation is a question for the jury, to be decided as a question of fact.

C. As a Direct Consequence of the Decision in Markman, Decisions That Have Historically Been Considered Questions of Fact Will Now Have to be Decided by the Court as Questions of Law.

The majority's decision in *Markman* in reclassifying questions of fact as questions of law will have profound and adverse consequences upon the entire judicial system. Factual issues that have historically been presented to the jury will now be forced upon the court. *See e.g., Booktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555 (Fed. Cir. 1992); *American Cyanamid Co. v. United States Surgical Corp.*, 833 F. Supp. 92 (D. Conn. 1993); *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410 (Fed. Cir. 1993); *RasterOps v. Radius, Inc.*, 861 F. Supp. 1479 (N.D. Cal. 1994); *Hoffman-LaRoche Inc. v. Burroughs Wellcome Co.*, 10 USPQ2D 1602 (D. Md. 1989).

For example, after the *Markman* decision, the court will now be forced to determine the meaning of "first electrical

comparator connected to the load measuring means measuring the polished rod load relative to a present load point" to an engineer skilled in designing fluid pumps, after listening to expert witness testify about its disputed meanings. *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d at 412 n. 1, 414-15.

There is simply no basis to conclude that a judge with a law degree is in a better position to weigh conflicting testimony of experts as to the meaning of a term of art in a patent claim than a jury of mixed credentials. Further, if a law degree qualifies one to better evaluate expert testimony as to the meaning of a technical term, why not apply the same rationale to disputed expert testimony in a medical negligence case or blood analysis in a criminal case? The Seventh Amendment is a rejection of the concept that only an elitist group of "qualified" individuals should determine disputed issues of fact. The interpretation of disputed issues of fact is not the courts' job. It is guaranteed to the jury under the Seventh Amendment to the Constitution.

II. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO CIRCUMVENT THE RULES OF EVIDENCE AS ESTABLISHED BY THIS COURT BY RECLASSIFYING DISPUTED CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT.

In reclassifying disputed claim interpretation as a question of law, the majority in *Markman* has abandoned recent evidentiary standards established by this Court. Moreover, issues that involve presentation of conflicting extrinsic evidence would be decided as a matter of law, in direct conflict with this Court's present interpretations of the Federal Rules of Evidence.

A. This Court Has Previously Found That Evidentiary Questions Requiring Presentation Of Conflicting External Evidence Is A Question Of Fact And Not A Question Of Law.

In patent cases, disputed questions of the meaning and scope of technological terms and words of art are to be decided from the viewpoint of persons skilled in the particular field of technology under dispute. Regardless of whether the meaning of the terms is classified as a question of fact or a question of law, if the meaning is disputed, the parties will be forced to provide extrinsic expert evidence. *See* Lovinger, *Science as Evidence*, 35 Jurimetrics J. 153 (1995); Weinstein, *The Effect of Daubert on the Work of Federal Trial Judges*, 2 Expert and Scientific Evidence Quarterly 1 (Shepard's 1994). Accordingly, the Federal Rules of Evidence, which regulate the admission of expert testimony, are extremely relevant to the issue presented in the case at bar.

The Federal Rules of Evidence address the admission of expert testimony under Rule 702 as a means of assisting the trier of fact. Federal Rule of Evidence 702 states:

> If scientific, technical, or other specialized knowledge will assist the *trier of fact* to understand the evidence or *to determine a fact in issue*, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise . . . (Emphasis added.)

Accordingly, from the express language of the Rule, the use of expert testimony is to assist the trier of fact.

As a further means of interpreting this rule, this Court addressed the role of novel scientific evidence in its recent decision in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*,

__ U.S. __, 113 S. Ct. 2786 (1993). This Court found that the use of expert testimony is to be a two-stage process in which both the court and the trier of fact are involved. *Id.* at 2794-97. The initial, pretrial stage is for the trial court to determine: (1) if the methodology of the expert testimony is reliable in itself (*id.* at 2794-95), and (2) if the expert testimony is even admissible (*id.* at 2795-96). The second stage, if the testimony is determined to be reliable and admissible, is for the *trier of fact* to determine the credibility to be given to the expert testimony at trial. *Id.*

In other words, once the trial court has found the evidence to be admissible, its role is over. The jury is then required to weigh the evidence as it is presented by the experts, and make a factual determination as to which position they find to be more credible.

This is where the majority in *Markman* has created a significant flaw in their decision in determining who should interpret disputed terms in claim interpretation. *The majority acknowledges that the use of extrinsic expert evidence is necessary in determining the appropriate interpretations of the terms in dispute. Markman v. Westview Instruments, Inc.*, 52 F.3d at 979, quoting *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 631 (Fed. Cir. 1987). However, in recognizing the need for extrinsic evidence, such as expert testimony, the majority has effectively precluded the trier of fact from ever weighing the credibility of the evidence.

This rationale, in itself, is in direct conflict with this Court's interpretation of Federal Rule of Evidence 702 which requires the trier of fact to weigh the expert testimony and determine the appropriate credibility. *Daubert*, 113 S. Ct. at 2795-96. In effect, the majority's decision in *Markman* has denied patent cases the availability of using Rule 702 at all because the purpose of the rule is to assist the trier of fact. *Id.*

This Court's conclusion that the weight and credibility of expert testimony is a question of fact is not unique to the decision in *Daubert*. This Court has held on numerous occasions that the weight and credibility of witness testimony belongs to the trier of fact, because that is one of the fundamental roles of the jury, regardless of whether the issues concern technological or complex scientific evidence. *See Sartor v. Arkansas Natural Gas Corp.*, 321 U.S. 620 (1944); *Aetna Life Ins. Co. v. Ward*, 140 U.S. 76, 88 (1891); *see also Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984).

The process of weighing the credibility of the expert testimony is not the same as deciding a question of law. When analyzing two conflicting expert testimonies, it is necessary to decide which position to accept and which position to reject. In addition, the testimony must be allocated the appropriate weight by the deciding party. This is not the analysis for determining a question of law. But, it is the function of the jury prescribed in the Constitution under the Seventh Amendment.

The majority's attempt to distinguish disputed claim interpretation is an exercise in futility. *See Markman*, 52 F.3d at 981; *see also Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, ____ F.Supp.____, 1995 WL 548544, *12 n.7 (D. Del. 1995) (criticizing *Markman*). The majority seems to suggest that analyzing opposing expert opinions concerning disputed term interpretations does not constitute weighing the evidence's credibility or making factual evidentiary findings. *Id.* That suggestion is rather unique in its origin, and it is directly in conflict with this Court's interpretation of Federal Rule of Evidence 702. *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S. Ct. at 2795-96.

B. Prior To The Decision In *Markman*, The Federal Courts Recognized That Interpretation Of Disputed Terms Requiring Expert Testimony Is A Question Of Fact.

The most serious error in the majority's holding in *Markman* can be seen by looking at the Federal Circuit's own precedents. Situations that demand the introduction of extrinsic expert testimony to support diametrically opposing positions is a classic question of fact. *See Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033 (Fed. Cir. 1987); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

In *Moeller*, the Federal Circuit acknowledged that the use of expert testimony is generally discretionary to the trial judge. *Moeller v. Ionetics, Inc.*, 794 F.2d at 657. However, the court went on to emphasize that in patent cases involving interpreting the meanings of disputed terms it becomes almost a necessity to involve extrinsic expert evidence. *Id.* Moreover, the court held that determining the meanings of the disputed terms after the admission of the expert evidence is a question of fact to be determined by a jury. *Id.*

The Federal Circuit again strengthened this position involving the use of expert testimony in *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033. The court concluded that when a patent claim is in dispute and it is necessary to look at extrinsic evidence, including the specification, the prosecution history, and other claims, the issue of claim interpretation becomes a question of fact. *Id.* at 1037. In holding such, the court determined that in light of the conflicting extrinsic evidence presented by the parties, the trial court's granting of summary judgment was inappropriate. *Id.*

In *Perini America*, the Federal Circuit again found that the use of conflicting extrinsic evidence created a factual issue for the jury. The court observed that legal conclusions are

dictated by established facts and not the other way around. 832 F.2d at 584. Accordingly, the court concluded that weighing disputed extrinsic evidence is not appropriate as a question of law and instead must be decided by the trier of fact. *Id.*

The precedent established by the Federal Circuit prior to the decision in *Markman* expressly demonstrates how the majority's decision is a complete flipflop in terms of established law. The use of extrinsic expert evidence to determine the appropriate meaning to disputed terms can only be a question of fact, and the *Markman* decision must accordingly be reversed.

III. THE FEDERAL CIRCUIT SHOULD NOT BE ALLOWED TO UNDERMINE THE FUNDAMENTAL RIGHT TO A JURY TRIAL BY RECLASSIFYING DISPUTED CLAIM INTERPRETATION AS A QUESTION OF LAW RATHER THAN A QUESTION OF FACT

A. The Seventh Amendment To The Constitution Guarantees Petitioners The Right To A Jury Trial And Must Be Protected.

Where, as here, a case presents a legal, as opposed to equitable, right to court adjudication, it falls under the scope of the Seventh Amendment of the United States Constitution. This Amendment, which guarantees the right to a jury trial, states:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

U.S. Const., amend. VII.

The Seventh Amendment confers upon litigants rights equal in scope to those that existed in the English Common Law of 1791, when the Amendment was adopted. The purpose of the Amendment was to "preserve the right to jury trial as it existed in 1791." *In re Lockwood*, 50 F.3d 966, 971 (Fed. Cir. 1995). The right to a jury trial guaranteed by the Seventh Amendment has also extended to statutory actions, subsequently developed, that are analogous to those decided in the courts of Eighteenth Century England. *Tull v. United States*, 481 U.S. 412, 417 (1987). The array of actions in which the Seventh Amendment guarantee applies is quite expansive. "In short, any adjudication of a legal, as opposed to an equitable, right falls within the scope of the Amendment." *Lockwood*, 50 F.3d at 972.

The Seventh Amendment guarantee of a jury trial applies to actions for patent infringement since such actions are "one[s] that would have been heard in the law courts of old England. [citations omitted]" *Markman*, 52 F.3d at 992 (Mayer, C.J., concurring). Additionally, the issue of patent validity has been found to be within the scope of the Seventh Amendment. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 603 (Fed. Cir. 1985), *modified*, 771 F.2d 480 (1985) ("The right to a jury trial on issues of patent validity that may arise in a suit for patent infringement is protected by the Seventh Amendment.")

The majority's decision below disregards history and precedent which place actions for patent infringement with the jury. The Seventh Amendment guarantee of a jury trial applies to patent infringement actions, and yet the court

below took the matter from the jury to render its own decision. This action must be corrected.

The common-law right of trial by jury in patent infringement cases must be protected. An issue of fact that falls within the scope of the Seventh Amendment must be determined by the jury. *Walker v. New Mexico & So. Pac. R. Co.*, 165 U.S. 593, 596 (1897). Where an issue is to be decided by the jury, as guaranteed by the Seventh Amendment, the court must respect the mandate of the Amendment. In such cases, "the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Id.*, 165 U.S. at 596.

The court must give deference to jury verdicts and allow the jury to fulfill its role as the finder of fact. "So long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues in particular types of cases be treated differently from similar issues in other types of cases." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

The Seventh Amendment and precedent applying its guarantee mandate that actions for patent infringement be determined by a jury. The actions of the majority below, which inexplicably run directly contrary to the past two hundred years of jurisprudence, must be reversed. The right to a jury trial, a fundamental right denied to petitioners, must be protected and preserved.

1. The Historical Role Of The Jury Must Be Maintained.

Chief Justice Rehnquist has stated that "The right of trial by jury in civil cases at common law is fundamental to our history and jurisprudence." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 388 (1979)(Rehnquist, C.J., dissenting). He

also remarked that "the scope and effect of the Seventh Amendment . . . perhaps more than with any other provision of the Constitution, are determined by reference to the historical setting in which the Amendment was adopted." *Id.* at 339. ATLA suggests that this history is particularly instructive with respect to the issue before this Court.

Those who view the jury trial as a mere procedural feature of our civil justice system overlook the fact that a war was fought, and lives lost, to win this right. A primary grievance of the American colonists was the extensive effort by England to shift the adjudication of civil and criminal disputes from colonial courts, where local juries sat, to Vice-Admiralty courts and other non-jury tribunals administered by judges beholden to the Crown. Roscoe Pound, THE DEVELOPMENT OF CONSTITUTIONAL GUARANTEES OF LIBERTY 69-72 (1957); Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 Minn. L. Rev. 639, 654 (1973); *Parklane Hosiery*, *supra*, 439 U.S. at 340 (Rehnquist, C.J., dissenting), *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 110 S. Ct. 1339, 1353 (1990)(Brennan, J., concurring). The colonists complained of this infringement through the Stamp Act Congress, the Continental Congress, and, finally, in the Declaration of Independence ("For depriving us in many cases, of the benefits of Trial by Jury"). Stephan Landsman, *The Civil Jury In America: Scenes From an Unappreciated History*, 44 Hastings L.J. 579, 595-97 (1993).

Independence from England did not diminish the sacredness of the jury in the eyes of the new Americans. Jefferson described the jury as "the only anchor yet imagined by man, by which a government can be held to the principles of its constitution. THE WRITINGS OF THOMAS JEFFERSON 71 (Washington ed. 1861). The proposed Constitution included the right to trial by jury in criminal cases, U.S. Const., Art. III, §2, cl.3. But the absence of an express guarantee of the

right in civil actions was condemned by the Antifederalists as sufficient cause to reject the entire Constitution. Their demand for an explicit guarantee of the right to trial by jury led to the adoption of a Bill of Rights as a condition to ratification of the constitution itself. Edith Guild Henderson, *The Background of the Seventh Amendment*, 80 Harv. L. Rev. 289, 195-98 (1966); Wolfram, *supra*, at 667-730 (extensive review of ratification debates); Landsman, *supra*, at 599.

Those who fought so strenuously for this right in 1791 saw the jury as an essential element of limited, democratic government. The jury was intended as a check on the power of the federal judiciary. Morris S. Arnold, *A Historical Inquiry Into the Right to Trial By Jury in Complex Civil Litigation*, 128 U. Pa. L. Rev. 829, 832-35 (1980). Reacting to their experiences at the hands of autocratic British judges,

> The founders of our Nation considered the right of trial by jury in civil cases an important bulwark against tyranny and corruption, a safeguard too previous to be left to the whim of the sovereign, or, it might be added, to that of the judiciary.

Parklane Hosiery Co. v. Shore, 439 U.S. 322, 343 (Rehnquist, C.J., dissenting). *See also Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 83 (1989)(White, J., dissenting)("The function of the civil jury is to diffuse the otherwise autocratic power and authority of the judge.").

In addition, the new Americans regarded juries "as more than a 'mode of trial'; they were instruments of local government as well." Arnold, *supra*, at 833. *See also*, Alan Howard Scheiner, *Judicial Assessment of Punitive Damages, the Seventh Amendment and the Politics of Jury Power*, 91 Colum. L. Rev. 142, 144-49 (1991). This view of the jury as

an element of self-government prompted de Tocqueville to observe:

> It would be a very narrow view to look upon the jury as a mere judicial institution; for however great its influence may be upon the decisions of the courts, it is still greater on the desitines of society at large. The jury is, above all, a political institution, and it must be regarded in that light in order to be duly appreciated. . . . [I]t always preserves its republican character, in that it places the real direction of society in the hands of the governed, or a portion of the governed, and not in that of the government.

Alexis de Tocqueville, 1 DEMOCRACY IN AMERICA 293 (Bradley revised. ed. 1945).

In view of this history the Supreme Court has consistently emphasized the fundamental nature of the right to jury trials and has viewed any curtailment with great disfavor. Describing the right to trial by jury as "a great constitutional right," the Court stated that "it is only in exceptional cases and for specific causes that a party may be deprived of it." *Grand Chute v. Winegar*, U.S. 373, 375 (1872). *See also, Jacob v. New York*, 315 U.S. 752, 753 (1943) ("The right of jury trial in civil cases at common law . . . should be jealously guarded by the courts."); *Lyon v. Mutual Benefit Assoc.*, 305 U.S. 484, 492 (1939) ("It is essential that the right of trial by jury be scrupulously safeguarded.").

The immense respect given to the Seventh Amendment and its accompanying deference in the courts must not be compromised. Since the ratification of the Seventh Amendment the right it guarantees has evolved; yet the

importance placed on the role of the jury has remained sacrosanct. This Court has repeatedly declared:

> Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.

Dimmick v. Schiedt, 293 U.S. 474, 486 (1935), quoted in *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 501 (1959); and in *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 110 S. Ct. 1339, 1344-45 (1990).

The jury's role has also served as a check on the power of the courts:

> The deference that courts give to jury verdicts is the mechanism by which the Constitution protects the jury right from encroachment by judges. It is not this court's option to violate that right, whether by denying such deference or by taking from the jury the trial of factual issues.

Markman, 52 F.3d at 1010-11 (Newman, C.J., dissenting).

This protective function will also be lost, or at least significantly diminished, if the holding of the court below is allowed to stand.

The majority's holding in *Markman*, which effectuated a taking from the parties of the right to trial by jury of disputed factual issues would significantly curtail the rights guaranteed by the Seventh Amendment. Accordingly, the action below should be examined closely and, as it cannot be sustained upon scrutiny, reversed. It is strikingly clear that the Federal

Circuit's action is not only contrary to its own precedent but also flies in the face of one of our most fundamental constitutional rights, the Seventh Amendment guarantee of a jury trial.

2. Complexity Of The Issues Is Not A Valid Reason To Remove An Issue Of Fact From The Jury.

The jury's role as the trier of fact must not be compromised merely because of the technical nature of the facts to be determined. A "complexity exception" to the right to a jury trial as guaranteed by the Seventh Amendment has been regularly *rejected*. *In re Financial Securities Litigation*, 609 F.2d 411, 432, (9th Cir. 1979) *cert. denied sub nom., Gant v. Union Bank*, 446 U.S. 929 (1980); *SRI International v. Matsushita Electric Corp. of America*, 775 F.2d 1107 (Fed. Cir. 1985) (Markey, C.J., additional views.).

The Seventh Amendment's application to patent cases does not include a disclaimer of nonapplicability when the material is allegedly too difficult for a jury to comprehend. The Constitution does not so denigrate the intelligence of its citizens. "We discern no authority and no compelling need to apply in patent infringement suits for damages a 'complexity' exception denying litigants their constitutional right under the Seventh Amendment." *SRI*, 775 F.2d at 1130.

As the Chief Justice has observed:

> [N]o amount of argument that the device provides for more efficiency or more accuracy or is fairer will save it if the degree of invasion of the jury's province is greater than allowed in 1791. The rule otherwise would effectively permit judicial repeal of the Seventh Amendment . . .

> The guarantees of the Seventh Amendment will prove burdensome in some instances; the civil jury was surely a burden to the English governors who, in its stead, substituted the vice-admiralty court. But, as with other provisions of the Bill of Rights, the onerous nature of the protection is no license for contracting the right secured by the Amendment.

Parklane Hosiery Co. v. Shore, 439 U.S. 322, 348 (Rehnquist, C.J., dissenting).

Although the majority below did not directly state its holding was based on the complex nature of the patent claim interpretation, it nonetheless has the effect of creating a complexity exception to the Seventh Amendment. Thus this concept should continue to be rejected by this Court and the erroneous decision of the court below should be reversed.

CONCLUSION

For the foregoing reasons stated above, the ATLA respectfully requests this Court to reverse the decision of the courts below.

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